

Remark:

The office action dated 09/21/2007 erred in committing several obvious technical issues against MPEP and common sense according to a person having ordinary knowledge in the art:

(A) Evaluate a claim as a whole - first technical issue of the office action dated 09/21/2007:

One common characteristic of the office action dated 09/21/2007 was that the ground of rejection indicated all subject claims are directed to a computer program. Listed below is a quotation of *MPEP 2106-II-C* last paragraph:

Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See e.g. USPQ 1, 9 (1981).

According to *MPEP 2106-II-C*, the applicant respectfully object the practice of the examination process to focus on the "software portion" of a claim, and ignoring the other portions of the subject claims that changes the nature of the subject claim into a statutory claim under 35 U.S.C. 101. Listed below are the examples:

Claim 86:

Claim 86 directs to a programming tool that has real world utility and holding a specific position in the invention categories of the PTO system. The office action erred to subjectively ignoring the claim language as a whole as required by patent law and change the direction of the claim from a programming tool claim, an obvious statutory real world article into to a "pure software" claim.

Claims 114, 120, 148, 175:

Claims 114, 120, 148, 175 recite specific pre-computer process performed. Pre-computer process transforms a claim into a statutory matter because they are the steps performed outside the servicing of a computer program. A claim having a physical pre-computer step actually performed by the user is clearly not an abstract idea to be rejected under 35 U.S.C. 101. This important point had been previously raised in applicant's previous arguments. The office action erred to focus into the "software portion" of the claim without considering the claim as a whole as required

by the patent law. The office action erred for failure to explain why a method claim involving a physical action performed outside the computer to be non-statutory.

Claim 120:

Claim 120 directs to programming and communication method between a local computer and a remote computers connected by a communication link. This is obviously a real world statutory application. The office action erred to focus into the "software portion" of the claim without considering the claim as a whole (including the linked computer system) as required by the patent law. Methods to program and communicate between remotely connected computers are statutory category of the patent system. The office action erred for failure to explain why a real world programming and communication method to be non-statutory.

(B) Failure to provide evidence to demonstrate the rejected claims, as a whole, lacks utility, according to MPEP 2107.02 IV - second technical issue of the office action dated 09/21/2007:

Listed below is a quotation of *MPEP 2107.02 IV*:

To properly reject a claimed invention under 35 U.S.C. 101, the Office must:

(A) make a prima facie showing that the claimed invention lacks utility, and

(B) provide a sufficiently evidentiary basis for factual assumptions relied upon in establishing the prima facie showing. In re Gaubert, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975).

The office action merely provided prima facie evidence why a portion (the software portion) of the rejected claim, lacks utility. The office action failed to provide prima facie showing why the rejected claim as a whole lacks utility. Listed below are the examples:

Claim 86:

The office action failed to provide prima facie evidence why a programming tool claimed in claim 86 lacked utility.

Claims 114, 120, 148, 175:

The office action failed to provide prima facie evidence why the programming methods of claims 114, 120, 148 and 175 that each comprises pre-program process performed outside the computer for programming a computing device lacks utility. The office action failed to provide prima facie evidence why the programming and communication method of claim 120 lacks utility.

(C) Failure to provide response to argument and evidences submitted - third technical issue of the office action dated 09/21/2007:

Listed below is a quotation of MPEP 707.07(f):

When the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

The previous office actions failed to provide response about the following arguments and evidence submitted:

1. The real world examples of claimed article (the programming tool) and process submitted, including the EMC57000 series programming tool which utilizes a table format programming software. How can a real world programming tool of similar nature in use to be a nonstatutory abstract idea?
2. The office action failed to consider the evidence submitted on 01/30/2003 that the Taiwan patent office – a country extremely strict on technology patents, recognizes utilities of the claimed invention, and granted an official patent to the subject application.
3. The office action failed to comment about previous arguments why real word articles and processes comprising pre-computer activities discussed in (A) and (B) above are abstract idea?
4. The office action failed to comment on applicant's response 06/19/2007, section (D) why the examination was conducted to focus in part B (the software portion) and completely ignore part A, the statutory real world portion of the subject claims?
5. The office action failed to comment or ignored applicant's response 06/19/2007, section (E) quoting MPEP 2107.02 III A and In re Langner that the applicant had provide sufficient support to satisfy the utility requirement of 35 U.S.C. 101.

(D) Acceptable format for acceptable "pure software" claim of computer program to overcome 35 U.S.C. 101:

The applicant had informally communicate with the examiner by email about the format for computer program related claims to overcome the rejection under 35 U.S.C. 101. The examiner provided to the applicant two types of applicable format for allowable computer program oriented claims as follow:

1. *"computer readable medium" encoded with _____*
 - [a] *"a computer program"*
 - [b] *"software"*
 - [c] *"computer executable instructions"*
 - [d] *"instructions capable of being executed by a computer"*

OR

2. *"a computer readable medium" _____ "computer program"*
 - [a] *storing a*
 - [b] *embodied with a*
 - [c] *encoded with a*
 - [d] *having a stored*
 - [e] *having an encoded*

Accordingly the applicant assumes the above format will be adequate for a "pure software" claim of a computer program to over a rejection under 35 U.S.C. 101. The applicant wishes to express his most sincere thanks to the professional service provided by the examiner towards an independent applicant.

The applicant had further trying to schedule a telephone interview with the examiner to finalize mutually agreeable proper wordings of independent claims according to the format provided by the examiner, so as to over the rejection under 35 U.S.C. 101. The

examiner indicated there had been time before the response was due. With repeated voice messages and reminder emails the applicant was unable to get in touch with the examiner. Accordingly the applicant respectfully submits the revised claims amended according to the two acceptable format provided by the examiner. This response is submitted on the last day of the three months statutory period to submit a response.

In addition, the examiner is respectfully directed to notice the fact that:

- (a) The applicant had already demonstrated evidences of real world utility applications and pre-computer process outside the computer as evidence to overcome the rejection under 35 U.S.C. 101;
- (b) It is improper to conduct examination based on a portion (the software portion) of a claim, while ignoring the statutory characteristics recited by the subject claims such as - programming tool, multiple computer programming, communication system and programming method reciting activities outside the computer.
- (c) The applicant is cooperative to incorporate the format proposed by the examiner for the software portion of the subject claims, even though they should not be required when points (1) and (2) discussed above are presented.

It means the applicant had already exhausted his effort trying to cooperate with the examiner to get the 101 rejection issue resolved as quick as possible.

(E) Background Information – the applicant was unfairly treated by the PTO with exceptionally long examination process:

- (a) Prosecution of the subject applicant is now over **NINE YEARS**, including one FWC and one RCE filing.
- (b) There had been several rounds of patent examination practise changes directed to computer program related patents during the past nine years. It is unfair to keep on delaying the prosecution of subject application and then keep on applying later new patent law standards to re-examine the claims of the subject application submitted over nine years ago. For example, previous patent examination procedure indicated a "safe harbor" for software related program to

overcome 35 U.S.C. 101 when there is "pre-computer" or "post-computer" activities included in the subject claims. The applicant submitted amendment of the claims according to the safe harbor by that time but there had not been response for several years. The claims are then rejected when the safe harbor are no longer in force. Obviously the applicant may suffer further if later change in patent examination process supersede the above two acceptable forms of "pure software" related claims proposed by the examiner.

Accordingly, if the best effort amendment submitted by the applicant according to the direction of the examiner is still not good enough, the applicant respectfully quoted MPEP 707.07(j) requesting the further support from the examiner to efficiently helping the applicant to provide proper wordings (without changing the core properties of the invention) that will overcome the rejection under 35 U.S.C. 101.

Respectfully submitted by,



Peter Lam
Applicant
20104 Wayne Ave.,
Torrance, CA 90503.

Telephone: (310) 320-9811
Fax: (310) 320-9812

I hereby certify that this correspondence is being fax to PTO by fax number 571-273-8300 on December 21, 2007 Pacific Time.



Peter Ar-Fu Lam